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10/713,319

11/14/2003

Sumita Rao

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EXAMINER

PRENDERGAST, ROBERTA D

ART UNIT

PAPER NUMBER

2628

MAIL DATE

DELIVERY MODE

05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/713,319

Applicant(s)

RAO, SUMITA

Examiner

Roberta Prendergast

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, 20-25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-25 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A set of animation segment files associated with displaying an animation, said set of animation files comprising: a first segment file configured to store a first subset of displayable images, the images not linked to each other; a callback instruction associated with the first segment file; a second segment file configured to store a second subset of displayable images, the images not linked to each other; a file identifier associated with the second segment file; and wherein the callback instruction is indicative of the file identifier, the first segment configured to be loaded to a memory readable by an animation engine and the second segment configured to be loaded to the memory after at least a portion of the memory used by the first segment has been designated as available is a non-functional data structure and is therefore non-statutory.

Data structures not claimed as embodied in computer-readable material are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other

Art Unit: 2628

claimed aspects of the invention, which permit the data structure's functionality to be realized.

Further, when nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18, 20-25 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 1, lines 13-16, have been amended to include the limitation "...generating a first segment file indicative of the first set of images, the first set of images not linked to each other; generating a second segment file indicative of the second set of images, the second set of images not linked to each other...".

Independent claim 13, lines 5-6, have been amended to include the limitation "...dividing the set of images into sequential subsets of images, each subset having a size up to a maximum size, where individual images have no link to another image...".

Independent claim 17, lines 4-5 and 11-12, have been amended to include the limitations "...retrieving a first segment file, the first segment file identifying a first subset of images, the first subset of images not linked to each other..." and "...retrieving a second segment file, the second segment file identifying a second subset of images, the second set of images not linked to each other...".

Independent claim 20, lines 3-4 and 6-7, have been amended to include the limitations "...a first segment file on a computer-readable medium and storing a first subset of displayable images, the images not linked to each other..." and "...a second segment file on a computer-readable medium and storing a second subset of displayable images, the images not linked to each other...".

Independent claim 24, lines 16-18, have been amended to include the limitation "...the first segment identifying a first set of images not linked to each other if there are a plurality of images, the second segment identifying a second subset of images not linked to each other if there are a plurality of images...".

Examiner respectfully submits that these particular limitations are not found in the disclosure of the invention as originally filed on 11/14/2003 and therefore the added

Art Unit: 2628

material is not supported by the original disclosure. All references to linking in the specification are drawn to linking the segment files or the subsets and not to linking the images themselves and the callback identifier is defined as identifying the file identifier of the next segment file not to identifying the file identifier of the next image while the action instruction is used to link or chain the subsets or to identify the last image for the long animation and is not used to link the images themselves, see page 5, lines 2-15 and page 12, lines 5-20.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

Applicant's arguments filed 3/13/2007, with regards the rejection of claims 20-23 under 35 U.S.C. 101, have been fully considered but they are not persuasive.

Applicant argues "...The amended independent claim 20 identifies a structural relationship that includes: a first segment file, a callback instruction, a second segment file, a file identifier, and a memory readable by an animation engine. Additionally, a functional interrelationship is described "wherein the callback instruction is indicative of the file identifier, the first segment configured to be loaded to a memory readable by an animation engine and the second segment configured to be loaded to the memory after at least a portion of the memory used by the first segment has been designated as available."...".

Examiner respectfully submits that amending claim 20 to read "...A set of animation segment files associated with displaying an animation, said set of animation

Art Unit: 2628

files comprising: a first segment file configured to store a first subset of displayable images, the images not linked to each other; a callback instruction associated with the first segment file; a second segment file configured to store a second subset of displayable images, the images not linked to each other; a file identifier associated with the second segment file; and wherein the callback instruction is indicative of the file identifier, the first segment configured to be loaded to a memory readable by an animation engine and the second segment configured to be loaded to the memory after at least a portion of the memory used by the first segment has been designated as available..." does not overcome the rejection under 35 U.S.C. 101 because the claim is written to a set of files which are data structures that by themselves are not capable of causing functional change in the computer. Further, there is no requisite functionality present to satisfy the practical application requirement the claim merely describes the structure of a set of animation segment files. The claim is directed to non-functional descriptive material since the files and the callback instructions that link them together do not cause functional change in the computer and therefore is not statutory.

Applicant then argues, with respect to 1-18, 20-25 and 28-30, "...Support for the first segment file 23 is provided from inter alia Page 13 - 18, and in Figure 1 of the filed patent application. Support for the second segment file 25 is provided from inter alia Page 13 - 16 of the filed patent application. Reference to the "set of images not linked to each other" and "dividing the set of images into sequential subsets of images, each subset having a size up to a maximum size" is provided by describing inter alia the

Art Unit: 2628

taking of a set images identified in an image list and segmenting that list into a series of subsets, wherein each subset has images that in the aggregate are smaller in size than the maximum size, which are clearly not linked together. See Page 11: Line 5-10 and Figure 1. Additional support is provided in the subsequent illustrative example of images that are segmented into a subset of images. See Page 11: Line 11 - Page 12: Line 4. Furthermore, the Applicant proceeds to describe the "linking" of the subset of images wherein "the action instruction may be used to link one of the subsets to the next sequential subset. In this way, the action instruction is useful to link or chain the subsets in the proper sequential order." See Page 12: Line 8 -11. Therefore, Applicant's description references a condition that is "not linked" and that is necessary to perform the "linking" that is described in the patent application...".

Examiner respectfully submits that all references to linking in the specification are to linking the segment files or the subsets and not to linking the images themselves and the callback identifier is defined as identifying the file identifier of the next segment file not to identifying the file identifier of the next image while the action instruction is used to link or chain the subsets or to identify the last image for the long animation and is not used to link the images themselves, see page 5, lines 2-15 and page 12, lines 5-20. Examiner further submits that since there is no express teaching of the linking together of the images themselves within the segment files or subsets then there can be no assumption that the limitation wherein images are not linked together is being taught in the specification as originally filed.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2628

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberta Prendergast whose telephone number is (571) 272-7647. The examiner can normally be reached on M-F 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on (571) 272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP 5/23/2007

  
Ulka Chauhan  
Supervisory Patent Examiner